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REMARKS

Claims 1-13, 15, 16, and 21-32 are pending in the present Application. Claims 1, 7, 24, 28, and 30 have been amended, and Claim 12 has been canceled, leaving Claims 1-11, 13, 15, 16, and 21-32 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Amended Claims

Claims 1, 7, 24, 28, and 30 have been amended to better define the invention. Support for the amendments to each of claims 1, 24, 28, and 30 can be found at least in original claim 12, the limitations of which have been incorporated into each of these, and in the specification, paragraphs [0016], [0025], and [0041]. Support for the amendments to claim 7 can be found at least in the specification, paragraph [0017].

Claim 7 has further been amended to correct an inadvertent typographical error ("araalkyl").

Canceled Claims

Claim 12 has been canceled accordingly. No new matter has been introduced by these amendments.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-5, 7, 9-13, 15, 24, 26, and 27 stand rejected under 35 U.S.C. § 102(a) and/or § 102(e), as allegedly being anticipated by U.S. Patent No. 6,800,804 to Igarashi et al. ("Igarashi"). Applicants respectfully traverse this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Barent Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Igarashi discloses a resin encapsulating layer formed from an epoxy resin, a phenolic resin, a curing accelerator, and at least one of a conductive particle and/or magnetic particle, the surfaces of which are subject to coating treatment with an insulating inorganic material. Col. 2,

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lines 40-52. As the Examiner has noted in the office action, Igarashi specifically discloses that the "particles whose maximum particle size is not larger than 200 μm (micrometers, i.e., 200,000 nanometers) and whose average particle size is in a range of 0.5-50 μm (micrometers, i.e., 500 to 50,000 nanometers) are used as the conductive particles and the magnetic particles." Col. 4, lines 36-39 (emphasis added). Igarashi thereby specifically defines both a maximum and an average size limitation for the conductive and/or magnetic particles used therein. Claims 1, 24, 28, and 30, as presently amended, each specifically claims a nanosized filler having an average largest dimension of less than or equal to about 200 nanometers. It will be appreciated that the conductive and/or magnetic particle size disclosed in Igarashi is significantly larger than that disclosed in the instant claims, and does not overlap with the average particle sizes claimed in the instant claims. Igarashi thus fails to disclose all elements of the instant claims as amended, and therefore does not anticipate the instant claims. Applicants therefore respectfully request the Examiner withdraw the § 102 rejection over Igarashi and allow the claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 6, 8, 16, 21-23, 25, and 32 are rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Igarashi. Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

The Claims under rejection each depend from independent Claims 1, 24, 28, or 30. As noted above, Igarashi fails to teach or disclose the average particle size claimed in independent Claims 1, 24, 28, and 30. Further, as disclosed above, Igarashi specifically

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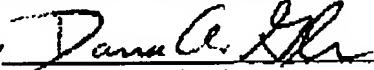
discloses average particle sizes that are larger than, and that do not overlap with, those disclosed in instant independent Claims 1, 24, 28, and 30 as amended. Igarashi thus provides no suggestion or incentive to modify the smaller particle size limitations of the instant claims. For these reasons the Examiner has not made a *prima facie* case of obviousness over Igarashi. Applicants therefore respectfully request a withdrawal of the rejection and an allowance of the claims.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0868.

Respectfully submitted,

CANTOR COLBURN LLP

By 
Dana A. Gronbeck
Registration No. 55,226

Date: March 28, 2006
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413